

REMARKS

Claims 1-3, 5-15 and 17-23 are pending in the application.

Claims 1-3, 5-15 and 17-23 have been rejected.

No claims have been amended, and reconsideration of the claims is respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 102

Claims 1, 2, 5, 12-14 and 17 were rejected under 35 U.S.C. § 102(e) as being anticipated by Baiyor, et al. (US 6,574,325 B1). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Baiyor describes a system in which an incoming call to a primary directory number is processed by a switch to generate multiple outgoing calls to a group of secondary directory numbers. Baiyor, Col. 4, lines 33-36. When the incoming call to the primary directory number is received by an associated switching center, the switching center retrieves from a database an alerting list containing the list of secondary directory numbers and begins placing outgoing calls to the secondary directory numbers. Baiyor, Col. 6, line 60, to Col. 7, line 15.

Independent Claims 1, 12 and 13 each recite accessing a database for a record corresponding to the destination number of an incoming call and determining whether call forwarding is active based upon information associated with the record. The independent claims further recite initiating outgoing calls to one or more forwarding numbers only upon the determination that call forwarding is active. In contrast, the system of Baiyor has no information in its database indicating whether or not call forwarding is active and, upon receiving a call to the primary directory number, always initiates outgoing calls to any secondary numbers in the retrieved alerting list.

Furthermore, independent Claims 1, 12 and 13 each recite that a subscriber line is associated with the destination number of the incoming call and that an outgoing call is initiated to the subscriber line in response to the receipt of the incoming call. An example of this element of the Applicant's invention is described in the Specification on page 5, lines 22-26. In the embodiment illustrated in Applicant's Figure 1, the subscriber line associated with the destination number of the incoming call is terminated by telephone 18 and, upon receiving the incoming call, central office 24 initiates an outgoing call to this subscriber line by sending a ringing signal to telephone 18. Thus, an outgoing call is initiated to a subscriber line associated with the destination number provided by the incoming call.

In the system of the Baiyor reference, the primary directory number has no subscriber line associated with it. Instead, the calling party dials the primary directory number to activate a terminating call service that implements "flexible alerting." The primary directory number is associated with a switching center, rather than a subscriber line, as recited in the claims.

For all these reasons, Baiyor fails to disclose each and every element of Applicant's claimed invention, as set forth in independent Claims 1, 12 and 13 (and Claims 2, 5, 14 and 17 depending therefrom). Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102 rejection of Claims 2, 5, 12-14 and 17.

II. REJECTION UNDER 35 U.S.C. § 103

Claims 3, 6-11, 15 and 18-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Baiyor, et al. (US 6,574,325 B1) in view of Otto (presumably US 6,163,606) or Brennan (presumably US 5,329,578). The rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

As set forth above in response to the 102 rejection, Baiyor fails to disclose one or more elements/features recited in Applicant's independent Claims 1, 12 and 13 (as amended). Neither of the secondary references appear to disclose, teach or suggest these elements/features as well. Therefore, none of the cited references, either alone or in combination, disclose teach or suggest Applicant's invention as claimed.

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection of Claims 3, 6-11, 15 and 18-23 .

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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